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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/575,500	04/11/2006	Xing Zhou	SC11.PAU.01.US	3932
23386 7590 12/24/2009 Myers Andras Sherman LLP 19900 MacArthur Blvd. Suite 1150 Irvine, CA 92612				
EXAMINER				
EASTWOOD, DAVID C				
ART UNIT		PAPER NUMBER		
3731				
MAIL DATE		DELIVERY MODE		
12/24/2009		PAPER		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

# Office Action Summary

**Application No.**

10/575,500

**Applicant(s)**

ZHOU ET AL.

**Examiner**

DAVID EASTWOOD

**Art Unit**

3731

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 02 December 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-11 and 13-20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-11 and 13-20 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 11 April 2006 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB06)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Response to Amendment***

Receipt is acknowledged of applicant's amendment filed 8/10/2009. Claim 12 has been cancelled without prejudice. Claims 1-11 and 13-20 are pending and an action on the merits is as follows.

### ***Claim Rejections - 35 USC § 102***

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 1, 7-11, 13, 15 and 19 rejected under 35 U.S.C. 102(b) as being anticipated by Conlon et al. (US 6409733).

**Regarding Claim 1, 7-11, 13, 15 and 19** , Conlon et al discloses an easily retrieved biological specimen pouch comprising a flexible wall (79), an open end (76) and a closed end (77), and said specimen pouch is configured for receiving a biological specimen during micro-invasive surgery through a small incision in a patient therein, said flexible wall of the open end of the specimen pouch has discontinuous serration (when the bag is in a closed state buckle points 85,86 buckle intermittently forming serrations see also C7 L43-50); on said serration, there are slots (opening above

serrations encapsulating string 95) through which a string can pass, wherein the string opens and closes the specimen pouch (Figure 8), wherein the string opens the specimen pouch when heated (when heated to their expansion temperature nitinol spring arms 47 (C4 L44-47) will begin to apply opening pressure to the rim of open end 76, release of string 95 frees the spring arms to expand thus opening the bag when heated), wherein one end of the said string (95) is connected with a slipknot or slip block (97), a noose structure (loop of string 95 surrounding bag 79) is formed when the other end passes through the slots in the serration of the open end in the specimen pouch and then the slipknot or slip block (97), wherein said flexible wall (79) of the specimen pouch is made of the soft macromolecule materials or compound materials, wherein said flexible wall (79) of the specimen, pouch is made of the soft macromolecule materials or compound materials which are enhanced by metal net or synthetic fiber, wherein said flexible wall (79) of the specimen pouch is made of the soft macromolecule materials or compound materials which are enhanced by memory alloy fiber net or synthetic fiber net, wherein said soft macromolecule materials are selected from the following elastomer or polymer materials: Silicon Rubber, Polyurethane, Polyethylene, Polypropylene, Silicone, Ethenoid Resin and Polytetrafluoroethylene (Column 6 lines 15-24), wherein said string (95) is Connected to a distant end of an inner sheath (26), and the specimen pouch (75) is installed in front of the distant end of the inner sheath and inside a distant end of an outer sheath (Figures 1 and 2), wherein said the relative position of the outer sheath (25) and inner sheath (26) is fixed by the orientation button (56).

With regard to claim 1, and the limitation "wherein said slots are shaped in the open end of the specimen pouch by a thermoplastic jointing of the flexible wall, and then the flexible wall of the open end is cut into said discontinuous serration." It is noted that the device of Conlon et al. appears to be substantially identical to the device claimed, although produce by a different process, therefore the burden is upon the applicant to come forward with evidence establishing an unobvious difference between the two. In re Marosi, 218 USPQ 289 (Fed. Cir. 1983).

### ***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

5. Claims 2-5, 16-18 and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Conlon et al (US 6409733) in view of Avellanet (US 6278057) further in view of Cope et al (US 5064428).

**Regarding Claims 2-5 and 16-17 and 20**, Conlon discloses the claimed invention except for said string is made of any materials which can save the changed shape and return to the original or near the original shape when disentangled, said string said string is an open spring made of any materials which can save the changed shape and return to the original or near the original shape when disentangled, said string/open spring is made of the following materials: shape memory alloy wires or pieces or alloy spring steel, wherein the pouch deployment and retrieval string returns to an open state based on temperature of a body.

However, Avellanet discloses nickel titanium alloy (nitinol) wires/strings for use with snares and surgical baskets (Column 4 example 1 and column 5 example 2) and are naturally trained to form a desired size in vivo (Column 5 lines 50-52), Cope et al teaches that nitinol is transformable from a deformed state to a predetermined trained shape once heated to it's operable range (Column 2 lines 47-65). It would have been obvious to one of ordinary skill in the art at the time of invention to modify the invention of Conlon with the nitinol string as taught by Avellanet. Doing so would provide a support structure for the entire circumference of the opening of the bag once deployed in vivo.

**Regarding Claim 18**, the invention of Conlon as modified by Avellanet discloses the claimed invention except for wherein the temperature is in the range of 15°C-33°C.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to set the shape memory alloy transformation temperature to the range of 15-33°C, since it has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art. In re Aller, 105 USPQ 233.

6. Claims 4-6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Conlon et al. (US 6409733) in view of Avellanet (US 6278057).

**Regarding claims 4-6**, Conlon discloses the claimed invention except for said string is an open spring made of any materials which can save the changed shape and return to the original or near the original shape when disentangled, wherein said open spring is made of the following materials: wires of macromolecule materials, compound materials or metal materials, shape memory alloy wires, shape memory alloy pieces and alloy spring steel. However, Avellanet discloses nickel titanium alloy (nitinol) wires/strings for use with snares and surgical baskets (Column 4 example 1 and column 5 example 2) and are naturally trained to form a desired size in vivo (Column 5 lines 50-52). It would have been obvious to one of ordinary skill in the art at the time of invention to modify the invention of Conlon with the shape memory alloy string as disclosed by Avellanet. Doing so would provide a means for further supporting the rim of the basket while deployed in vivo.

7. Claim 14 is rejected under 35 U.S.C. 103(a) as being unpatentable over Conlon (US 6409733) in view of Matey et al (US 5649021).

**Regarding Claim 14**, Conlon discloses the claimed invention except for said open end of the specimen pouch is colored distinctly from the biological specimen observed under the endoscopic equipment.

However, Matey discloses a laparoscopic tool used in vivo having a unique color marker not found on the interior of the abdomen (Column 3 lines 55-59). It would have been obvious to one of ordinary skill in the art at the time of invention to modify the invention of Conlon with the contrasting color as taught by Matey. Doing so would provide a specimen bag which would be easily identifiable with known endoscopic devices in vivo.

### ***Response to Arguments***

Applicant's arguments filed 12/02/2009 with respect to the Spector (US 5135222) reference have been considered, while the Examiner does not presently acquiesce to applicant's arguments they are moot in view of the withdrawal of the rejections relying on the Spector reference.

In regards to applicant's arguments that Conley fails to disclose inter alia serrations and a channel through which a string may pass, the Examiner notes that these arguments are addressed by a new grounds of rejection as set forth above.

Applicant's arguments filed 12/02/2009 have been fully considered but they are not persuasive. Applicant states that Cope does not disclose inter alia a device which opens upon being exposed to body temperature alleging that Cope teaches away from



this. The examiner disagrees, Cope discloses that the device is above transformation temperature (open state) when in **OPERATING CONDITION** (C 2 L 61). The examiner is interpreting this **operating condition** as being **in vivo** at body temperature, approx. 98.6 deg. Fahrenheit, while room temperature is well below this thus capable of being below the transformation temperature in which the basket would be in a contracted non-expanded state. In light of this interpretation Cope discloses a basket which opens upon being exposed to body temperature.

### ***Conclusion***

8. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to **DAVID EASTWOOD** whose telephone number is

(571)270-7135. The examiner can normally be reached on Monday thru Friday 9 a.m. to 5 p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Anhtuan Nguyen can be reached on (571)272-4963. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/DAVID EASTWOOD/  
Examiner, Art Unit 3731

/Anhtuan T. Nguyen/  
Supervisory Patent Examiner, Art Unit 3731  
12/18/09